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EXAMINER

FLYNN, KEVIN H

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WAYNE MALKIN

Appeal 2014-003911
Application 11/958,182¹
Technology Center 3600

Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and
AMEE A.SHAH, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's non-final rejection of claims 1–5, 8–12, 14–17, and 20–25. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM IN PART.

¹ Appellant identifies International Business Machines Corporation as the real party in interest. Appeal Br. 3.

THE INVENTION

Appellant claims relate to “systems and methods for analyzing, simulating and optimizing a defined workflow.” (Spec. para. 4).

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A computer-implemented method, comprising:
 - measuring cost data generated by repeated execution of a physical process, wherein each activity of the physical process is assigned to a stage in a multi-stage workflow, wherein a financial model associated with the multi-stage workflow contains at least one activity-based cost for performing each activity of the physical process;
 - estimating, by operation of one or more computer processors, a distribution of costs between at least two of the stages of the multi-stage workflow based on the measured cost data, wherein the distribution of costs assigns a cost value to each activity-based cost in the multi-stage workflow;
 - determining, based on the distribution of costs, a plurality of simulated distribution of costs and a plurality of simulated total revenues by iteratively varying a value of at least one parameter associated with at least one activity, wherein varying the value of the at least one parameter varies the activity-based cost of the at least one activity; and
 - upon determining a maximum profit based on the plurality of simulated distribution of costs and the plurality of simulated total revenues, determining a process change for the multi-stage workflow based on the value of the at least one parameter that yields the maximum profit.

(Appeal Br. 16).

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Hwang	US 2003/0220828 A1	Nov. 27, 2003
Jin	US 2003/0233273 A1	Dec. 18, 2003
Dismukes	US 2004/0034555 A1	Feb. 19, 2004

The following rejections are before us for review.

Claims 21–25 are rejected under 35 U.S.C. § 112(pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

Claims 1–5, 8–12, 14–17, and 20–25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dismukes in view of Jin in view of Hwang.

FINDINGS OF FACT

1. Jin discloses:

Another example of an input parameter change is to reduce the time cost of the resource Get₁₃ Approval (which is usually a role that is performed by a manager. Simulation results show that the average cycle for the first and second simulation are 2.09 hours and 2.13 hours respectively. If the cost of the resource Get₁₃ Approval is cut in half, the average business process cycle drops to 1.89 hours. Furthermore, resource utilization of Get₁₃ Approval drops to 18.88 from 37.74.

Para. 54.

ANALYSIS

35 U.S.C. § 112 second paragraph rejection

We affirm the rejection of claims 21–25 under 35 U.S.C. § 112, second paragraph, because the Appellant offers alternative language which we take to be an admission to the language the Examiner cites as problematic. (Answer 2, *see also*, Appeal Br. 7).

35 U.S.C. § 103(a) Rejection

Each of independent claims 1, 9, and 14 recites, in pertinent part, *determining, based on the distribution of costs, a plurality of simulated distribution of costs and a plurality of simulated total revenues by iteratively varying a value of at least one parameter associated with at least one activity, wherein varying the value of the at least one parameter varies the activity-based cost of the at least one activity;*

(Appeal Br., Claims App. (emphasis added)).

The Examiner found concerning this limitation that:

Jin, in Fig. 6, ¶ 0043, ¶¶ 0045-0046, ¶ 0052 discloses iterative variation of a parameter which results in ¶¶ 0054-0055 varying the activity costs as well as determining a distribution of costs.

(Non-Final Act. 4).

Appellant, however, argues that:

Simply put, various simulations can be executed and analyzed based on changing the value of the parameters, and the parameters can be modified manually or by retrieving historical information. *Jin* teaches, however, that “[b]**usiness process developers** can use custom statistics to create customized combinations of the standard statistics (e.g., setting cost

information or revenue formulas).” ¶ [0052] (emphasis added). In other words, *Jin* teaches that a developer can use the statistics generated from the output of the simulations and manipulate those statistics for use in revenue formulas. This brief disclosure that statistics may be used in revenue formulas does not teach the specific recitation in the independent claims of iteratively varying a parameter to determine a plurality of simulated total revenues. For example, *Jin* never discloses if the revenue formulas derive a plurality of simulated total revenues.

(Appeal Br. 10).

We agree with Appellant. Appellant’s Specification does not specifically define the term “iterative”, nor does it utilize the term contrary to its customary meaning. The ordinary and customary definition of the word “iterative” is: “involving repetition: . . . *b*: relating to or being iteration of an operation or procedure.”² The claims require “*determining, based on the distribution of costs, a plurality of simulated distribution of costs and a plurality of simulated total revenues by iteratively varying a value of at least one parameter associated with at least one activity, by iteratively varying a value of at least one parameter associated with at least one activity.*” Thus, the determining step must be part of a process by which an activity parameter is repeatedly varied which results in the determination of “*a plurality of simulated distribution of costs and a plurality of simulated total revenues.*” While Jin at paragraphs 54 and 55 discloses that varying the resource Get₁₃ Approval value results in a corresponding average business process cycle drop to 1.89 hours (FF. 1), there is no disclosure of repeatedly varying the resource Get₁₃ Approval value to effect a determination. The

² <http://www.merriam-webster.com/dictionary/iterative> (last visited 11/16/2016).

section cited by the Examiner merely discloses that by changing the Get₁₃ Approval value, a corresponding change in the average business process cycle occurs. Thus, we will not sustain the rejection of independent claims 1, 9, and 14.

Since claims 2–5, 8, 10–12, 15–17, and 20–25 depend from claim 1, 9, and 14, and since we cannot sustain the rejection of claims 1, 9, and 14, the rejection of claims 2–5, 8, 10–12, 15–17, and 20–25 likewise cannot be sustained.

CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting claims 21–25 under 35 U.S.C. § 112 second paragraph.

We conclude the Examiner did err in rejecting claims 1–5, 8–12, 14–17, and 20–25 under 35 U.S.C. § 103(a).

DECISION

We affirm the Examiner's decision to reject claims 21–25 under 35 U.S.C. § 112 (pre-AIA), second paragraph.

We reverse the Examiner's decision to reject claims 1–5, 8–12, 14–17, and 20–25 under 35 U.S.C. 103(a) as being unpatentable over Dismukes in view of Jin in view of Hwang.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED IN PART